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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,779	02/22/2002	Xiaoqing Suzy Zeng	67159	1140

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EXAMINER

MADSEN, ROBERT A

ART UNIT PAPER NUMBER

1761

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/080,779	Applicant(s) ZENG, XIAOQING SUZY	
	Examiner Robert Madsen	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to a beverage system comprising mixing indicia, classified in class 426, subclass 87.
  - II. Claims 16-22, drawn to a method of using a beverage system by adding liquid to a concentrate, classified in class 426, subclass 506.
2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the beverage system as claimed can be used to practice another and materially different process (e.g. the inner cups can be emptied into an external container for mixing, rather than the outer cup).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Jon Birmingham on December 12, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,2,9-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shanklin (US 4627334).

7. See Abstract, Column 4, lines 13-65, Column 6, lines 21-25

8. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schwartz (US 4756424).

9. See Column 1, lines 5-21, Column 2, lines 50-68, and Figures 1 and 2, wherein the outer cup is 10' and an inner cup is item 40.

10. Claims 1,2,4,9,11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Robinson (US 4934525).

11. See column 1, lines 45-67, column 2, lines 43-68, and Figures 4-6.

12. Claims 1,3, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Muraoka (US 4018904).

13. See Column 2, line 21 to Column 3, line 66, and Figures 1-6.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4,7,8,12,13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 4756424) as applied to claims 1-3,9-11 above, further in view of Maddox (US 3620759).

16. Regarding claims 4,7,12,13, and 15, Schwartz teaches placing instant coffee in the inner cups (Column 1, lines 5-21, Column 2, lines 50-68), but is silent in teaching the coffee is held within gelatin capsules, which are notoriously well known to be translucent, that dissolve in liquid and can be opened, as recited in claims 4,7,12,13,15.

17. Maddox teaches instant coffee may pick up water during storage, which results in handling, measuring, and flavoring problems. Maddox teaches that by placing instant coffee into a gelatin-based capsule that dissolves in liquid and can be opened by dissolving, moisture pick-up can be avoided and the handling/flavoring improved (Column 1, lines 4-30, Column 1, line 50 to Column 2, line 11).

18. Therefore it would have been obvious to modify Schwartz and include instant coffee contained within translucent gelatin capsules that dissolve in liquid and can be opened, as recited in claims 4,7,12,13,15, since Maddox teaches gelatin capsules will provide an easier to handle coffee with an improved flavor after storage and one would have been substituting one conventional type of instant coffee for another.

19. Regarding claim 8, Schwartz is silent in teaching any nutritional supplements. However, Maddox teaches that when using gelatin based capsules to deliver the instant coffee, one may consider adding nutritional supplements to the capsules to result in a complete food nutriment (Column 3, lines 37-45). Therefore, to further add nutritional supplements to the coffee of Schwartz would have been an obvious matter of choice, depending on whether one desired a complete food nutriment, since Maddox teaches one may consider adding nutritional supplements to an instant coffee to provide a complete food nutriment.

20. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 4756424) as applied to claims 1-3,9-11 above, further in view of Gramm (US 6180149 B1).

21. Schwartz teaches coffee or tea in the inner cups, but is silent in teaching the outer cup has measuring indicia and both outer and inner cups are made of translucent polymers. Gramm also teaches tea inner containers within an outer container for preparing a tea beverage. Gramm further teaches utilizing plastic transparent outer cups, with measuring indicia, to determine the desired liquid level and plastic

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transparent inner cups to enhance the appeal of the package to consumers by allowing them to view the contents of the inner cup (Column 3, lines 51-60, Column 4, lines 18-20, Column 5, lines 27-37, Column 5 line 65 to Column 6, line 15.) Therefore, it would have been obvious to modify the cups of Schwartz since Gramm teaches transparent outer cups allow for measuring the liquid and transparent inner cups enhance the appeal of the package to consumers. One would have been substituting one conventional cup material for another for the same purpose.

22. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US 4756424) as applied to claims 1-3,9-11 above, further in view of Leever (US 1931765).

23. Schwartz teaches placing instant coffee in the inner cups (Column 1, lines 5-21, Column 2, lines 50-68), but is silent in teaching the coffee is held within capsules that comprise two halves joined at an area of weakness and are opened to add the coffee to the outer cup.

24. Leever also teaches utilizing coffee concentrate to make coffee and teaches providing coffee in two capsule portions to maintain freshness and prevents foreign matter from contaminating the coffee, and the cover portion (i.e. item 5) is separated from the cap portion (i.e. item 3) at the area of weakness, or seam of bands 6/7, prior to adding to water (Page 1 lines 1-12, 45-105).

25. Therefore, it would have been obvious to modify Schwartz and include coffee held within capsules that comprise two portions joined at an area of weakness and are

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opened to add the coffee to the outer cup since Leever teaches this maintains the freshness of the coffee, and one would have been substituting on form of concentrated coffee for another. To select "halves" as being the shape of the two portions would have been an obvious matter of design since this would not have any impact on the functionality of the capsule: protecting the coffee during storage.


### ***Conclusion***


26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buchel (US 4186215) teaches an outer beverage cup with an inner cup for mixing with the outer cup. Castillo (US 6363978 B2) and Castillo (US 6263923 B1) both teach outer containers with inner containers comprising an ingredient to be added to the outer container.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-0061.

  
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Robert Madsen   
Examiner  
Art Unit 1761